

REMARKS

This application has been reviewed in light of the Office Action dated April 10, 2006. Claims 1-20 remain pending. Claims 1, 13, and 19 are in independent form. Favorable reconsideration is requested in view of the following remarks.

The Rejection Under 35 U.S.C. 101

Claims 1-20 were rejected under 35 U.S.C. 101 because, the Office Action states, “the claimed invention is directed to non-statutory subject matter.” According to the Office Action, “[t]he rejected claims appear to be directed to computer program” and “Claims 1-20 are . . . rejected [because] there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer.” In support of these assertions, page 12 of the Office Action states:

The applicant argues in substance that the office action does not identify any reasons why the examiner believes that Claims 1-20, which recite a ‘system’, are directed to a computer program. The examiner believes this is because the applicant makes this disclosure in page 7 of his specification (i.e., the system of the present invention can be operated by programs resident on the server side or operated by application programs that are executed by a CPU, see pg 7 lines 5-10).”

Initially, one of the above-quoted statements from the Office Action characterizes Claims 19 and 20 as being directed to a “computer program”, and another one of the above-quoted statements from the Office Action characterizes Claims 19 and 20 as reciting a “system”. However, neither characterization is correct because Claims 19 and 20 explicitly recite a “method”. A “method” clearly is well-recognized as being patentable

subject matter under 35 U.S.C. 101. Indeed, Section 101 states “Whoever invents or discovers any new and useful process, . . . may obtain a patent therefor” According to 35 U.S.C. 100(b), “The term ‘process’ means process, art, or *method*” (Emphasis added). Accordingly, a “method” clearly falls within the definition of a “process” as set forth in Section 101, and thus claimed subject matter directed to a “method”, such as that recited in Claims 19 and 20, clearly falls within the scope of subject matter recognized by Section 101 as being patentable.

As for the Office Action’s assertion that Claims 1-18 “appear to be directed to computer program”, Applicants again take no position at this time as to whether or not any of those claims is directed to such subject matter. Nonetheless, the Section 101 rejection of those claims is believed to be improper for the following reasons.

As can be seen in the above-quoted portion from page 12 of the Office Action, the basis for the Action’s allegation that Claims 1-20 are directed to a computer program is a sentence appearing at page 7, lines 6-8 of the specification, which reads:

“The system of the present invention can be operated by programs resident on the server side or operated by application programs that are executed by a CPU.”

Apparently, the Office Action essentially has interpreted the foregoing statement as estopping Applicants from seeking patent protection for any type of subject matter besides a computer program. However, this interpretation is strongly disagreed with for the following reasons.

As shown above, the quoted statement from page 7, lines 6-8 of the specification states merely that “[t]he system of the present invention *can be operated* by programs . . . or *operated by* application programs” (Emphasis added). Clearly, this statement merely identifies one possible way in which the present invention can be *operated*, at least in part, and does not place any limitation on the types of subject matter which Applicants may claim for patent protection. Indeed, the word “operate” is defined in Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., p. 827 (1985) as meaning, for example, “1: to perform a function . . . 2: to produce an appropriate effect . . . 3 a: to perform an operation or a series of operations” Nothing in those meanings (even if, assuming *arguendo*, they are deemed applicable in the instant case), and nothing anywhere in the statement appearing at page 7, lines 6-8 of the specification, reasonably could be interpreted as an estoppel prohibiting Applicants from seeking patent protection for subject matter other than a computer program.

In keeping with the requirement of MPEP § 2111, Rev. 3, August 2005, the claims must be given their broadest reasonable interpretation, at least for the purposes of examination,¹ and thus should not necessarily be limited during examination only to the interpretation attributed to them by the Office Action.²

1/ Applicants take no position at this time as to whether any of those claims should be interpreted as computer program subject matter or as other-than computer program-type subject matter, after a patent has issued on the present application, nor is any statement made herein intended to mean that the claims should be construed in one or another of those ways upon a patent being issued.

2/ If the Examiner believes otherwise, he is respectfully requested to explain
(continued . . .)

Furthermore, even if, assuming *arguendo*, Claims 1-18 are construed to be directed to a computer program, the U.S. Patent and Trademark Office has issued at least one other patent having claims reciting a computer program, which is not explicitly recited as being embodied on a computer-readable medium. *See, e.g.*, Claim 8 of U.S. Patent 7,055,309, issued as recently as June 6, 2006.

In view of all the foregoing remarks, it is believed that the Section 101 has been obviated. Accordingly, withdrawal of the Section 101 rejection is respectfully requested.

The Rejection Under 35 U.S.C. 103(a)

Claims 1-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over “CHECK ADJUSTMENT REQUEST FEDERAL RESERVE BANK“ from http://www.richmondfed.org/financial_services/check/adjustments/pdf/request-form.pdf), in view of “Electronic Check Adjustments Federal Reserve Bank” from <http://www.stlouisfed.com/publications/pq/1998/a/pq1998a5.html>, and further in view of the article entitled “Banks turn to web for check processing”, by Ellen Messmer, published in Network World on June 19, 2000, vol. 17, Iss. 25, p. 53, pp. 1-3 (hereinafter, the Network World article”), printed from a website having a homepage at <http://proquest.com>.

A Declaration under 37 C.F.R. §1.132 evidencing that all the referenced subject matter of the Network World article was derived from Applicants (see MPEP

2/ (. . . continued)

why the words “can be operated by” would negate the requirement that the claims be given their broadest reasonable interpretation during examination.

§2133.03, Rev. 3, August 2005, at 2100-84) is currently being executed and will be filed immediately upon receipt. The Examiner is respectfully requested to telephone the undersigned if the file is reached for action before the Declaration is made of record therein.

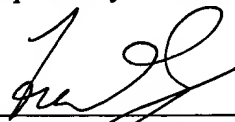
Because the Network article describes Applicants' own work, the article does not constitute prior art against the present application under 35 U.S.C. 102(a). Neither is the Network World article understood to qualify as prior art under any other subsection of 35 U.S.C. 102.

Accordingly, it is believed that the rejection of Claims 1-20 under 35 U.S.C. 103(a) has been obviated, and its withdrawal is therefore respectfully requested.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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